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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,609	07/05/2000	Joon Maeng	M-8308 US	4071

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EXAMINER

MISTRY, O NEAL RAJAN

ART UNIT PAPER NUMBER

2173

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/609,609

Applicant(s)

MAENG, JOON

Examiner

O'Neal R Mistry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 23-24, drawn to Group 1, classified in class 345, subclass 752.
- II. Claims 14-22, drawn to Group 2, classified in class 345, subclass 716.

1. The inventions are distinct each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has a different mode of operation to provide a electronic mail system with enhanced capabilities of attaching audio and video data to electronic file. In the instant case, invention II has a different mode of operation transmitting data packets via network by concatenating audio, video, and text data packets into a single packet. See MPEP 806.05(d).

2. Because the inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and because the search required for Group I is not required for Group II a restriction for examination purposes is indicated is proper.

3. During a telephone conversation with Applicants' Attorney, Robert Holland, on September 21, 2004, Group 1 elections was made.

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4. Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently name inventors is no longer an inventor of at least once claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Drawings

5. The Examiner contends that the drawings submitted on July 05, 2000 are acceptable for the examination proceedings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1-4,6-13, 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Cleron et al (U.S. Patent Number 6,223,213).

7. In regards to claim 1, Cleron discloses a method of asynchronous communication by a plurality of users via a network of interconnected computers, comprising:

selecting, at a client site, a file and capturing said file as an image file(col. 2 lines 1-3) [The thin client is equipped with a microphone and video input to receive audio and video data.]. The examiner interprets that client has the ability to receive audio and video data from the client's microphone and video input;

creating, at said client site, an audiovisual message, said audiovisual message relating to said tile, said creating comprising capturing digital information (col. 2 lines 1-3) [The thin client is equipped with a microphone and video input to receive audio and video data.]. The examiner interprets that by the client equipped with a microphone and video input, the purpose of this items are create and capture digital information for an audiovisual message;

appending said image file and said audiovisual message to achieve a combined message (col. 1 line 66 – col. 2 line 1) [the email system allows the thin client to capture audio and video data for inclusion with the email message.]. The examiner interprets that by capture the audio and video data the electronic mail being sent out is also an audiovisual message; and

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electronically delivering said combined message to at least one of said plurality of users (col. 2 lines 18-20) [After the user has reviewed the email message, the user can click a "Send" link on the rendered email page to send the email message to an intended recipient.].

8. In regards to claim 2, Cleron discloses said electronically delivering comprises streaming said digital information via said network (col. 2 lines 24-27) [the host mail server converts the email message and the audio or video data to a MIME message (Multipurpose Internet Mail Extensions) and forwards the MIME message to the intended recipient, where it can be rendered in full.]. The examiner interprets that a mail server is used to electronically send data across a network.

9. In regards to claim 3, Cleron discloses further comprising creating a reply record, said reply record having audiovisual material, said reply record being in response to said combined message (col. 2 lines 3-6 & col. 1 line 66- col. 2 line 1) [The client browser supports a user interface that includes pop-up capture panels for both audio and video, with each capture panel enabling the user to record a selected clip and add the clip to the email message.][the email system allows the thin client to capture audio and video data for inclusion with the email message.]. The examiner interprets that user has the ability to create audiovideo message, so if a user were to receive an email, the user has the ability to create a reply

using the same feature to create an audiovideo message to reply in response to the email.

10. In regards to claim 4, Cleron discloses said reply record is created by one of said plurality of users, and further wherein said one of said plurality of users annotates said image file (col. 1 line 66- col. 2 line 3) [According to one aspect of the invention, the email system allows the thin client to capture audio and video data for inclusion with the email message. The thin client is equipped with a microphone and video input to receive audio and video data.]. The examiner interprets the claim for creating a reply that has both audio and video data file, with in the combined electronic mail.

11. In regards to claim 6, Cleron discloses said creating comprises accessing a user interface, said user interface having stateful buttons (col. 2 lines 3-6) [The client browser supports a user interface that includes pop-up capture panels for both audio and video, with each capture panel enabling the user to record a selected clip and add the clip to the email message.].

12. In regards to claim 7, Cleron discloses said selecting further comprises activating said image file for editing (col. 2 lines 18-20) [After the user has reviewed the email message, the user can click a "Send" link on the rendered email page to send the email message to an intended recipient.].
The examiner interprets that the user has the ability to review the electronic mail before

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it is being sent is a form of editing, because if the user does not like the recording for audio or video file, the user has the ability to recapture the files.

13. In regards to claim 8, Cleron discloses said electronically delivering comprises transmitting said combined message to a central server for storage and further transmission (col. 2 lines 24-27) [Upon receiving this second request, the host mail server converts the email message and the audio or video data to a MIME message (Multipurpose Internet Mail Extensions) and forwards the MIME message to the intended recipient, where it can be rendered in full.].

14. In regards to claim 9, Cleron discloses a method of creating and delivering an electronic audiovisual message via a network of computing means, comprising:

capturing at least a portion of an electronic document as an image file (col. 2 lines 1-3) [The thin client is equipped with a microphone and video input to receive audio and video data.]. The examiner interprets that client has the ability to receive audio and video data from the client's microphone and video input;

annotating said image file (col. 1 line 66 – col. 2 line 1) [the email system allows the thin client to capture audio and video data for inclusion with the email message.];

creating said electronic audiovisual message, said electronic audiovisual message regarding said electronic document (col. 2 lines 1-3) [The thin client is equipped with a microphone and video input to receive audio and

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video data.]. The examiner interprets that by the client equipped with a microphone and video input, the purpose of this items are create and capture digital information for an audiovisual message;

combining said annotated image file and said electronic audiovisual message into a combined message (col. 1 line 66 – col. 2 line 1) [the email system allows the thin client to capture audio and video data for inclusion with the email message.]. The examiner interprets that by capture the audio and video data the electronic mail being sent out is also an audiovisual message; and

delivering said combined message to at least one desired recipient via said network(col. 2 lines 24-27) [Upon receiving this second request, the host mail server converts the email message and the audio or video data to a MIME message (Multipurpose Internet Mail Extensions) and forwards the MIME message to the intended recipient, where it can be rendered in full.].

15. In regards to claim 10, Cleron discloses replying to said combined message via said network, wherein said replying comprises creating an audiovisual reply designated for insertion at a predetermined point in said combined message (Figure 8).

16. In regards to claim 11, Cleron discloses said replying comprises delivering said audiovisual reply with an address pointer indicative of said predetermined point (Figure 8). The examiner interprets that in Figure 8 the user has the replay electronic mail with audiovisual reply to address where it should be delivered.

17. In regards to claim 12, Cleron discloses said delivering comprises storing said combined message at a remote location and sending an electronic notification having a uniform resource locator corresponding to said location (col. lines 47-50). The email system uses HTTP, which also uses uniform resource locator.

18. In regards to claim 13, Cleron discloses said delivering comprises streaming said combined message to said at least one desired recipient via the Internet (col. 2 lines 24-27) [Upon receiving this second request, the host mail server converts the email message and the audio or video data to a MIME message (Multipurpose Internet Mail Extensions) and forwards the MIME message to the intended recipient, where it can be rendered in full.].

19. In regards to claim 23, Cleron discloses a machine-readable storage medium comprising a set of instructions executable by a computer system to implement a method, the method comprising:

providing a graphical user interface to allow a user to select desired content as an image file;

permitting said user to annotate said image file (Figure 5;

capturing audiovisual material responsive to said image file as a digital file

(Figure 6 & Figure 7);

pairing said digital file and said annotated image file as a combined file (Figure 8); and

delivering said combined file to at least one desired location via said computer system (col. 2 lines 24-27) [Upon receiving this second request, the host mail server converts the email message and the audio or video data to a MIME message (Multipurpose Internet Mail Extensions) and forwards the MIME message to the intended recipient, where it can be rendered in full.]. The mail server is considered to be a computer.

20. In regards to claim 24, Cleron discloses wherein the machine-readable storage medium includes any of magnetic storage medium, including disk and tape storage medium', optical storage medium, including compact disk memory and digital video disk storage medium; nonvolatile memory storage memory; volatile storage medium; and modulated, electronic signals. (col. 9 line 45- col. 10- 17) [13. A thin client comprising: a processor; a memory coupled to the processor; a data input to receive a data stream; a browser program stored in the memory and executable on the processor, the browser rendering pages written in a markup language to present an email interface for reading and writing email messages; a user interface stored in the memory and executable on the processor to enable capture of the data stream received at the data input for inclusion in an email message; wherein upon a user command to add the data stream to the email message, the browser submits a request to a host mail server for a second page that contains the email message with the data stream

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included therein; and wherein the browser receives a response specifying a new page that contains the email message and indicating a location in the second page at which the data stream is to be rendered.]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cleron et al (U.S Patent Number 6,223,213) in view of Freivald (U.S. Patent Number 6,219,818).

Cleron shows a browser-based email system that incorporates audio and video data with the document but does not show annotating at least a portion of said image file using a cursor-based highlighter.

Freivald shows annotating at least a portion of said image file using a cursor-based highlighter (col. 7 lines 10-13) [The user can select paragraphs of

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text by dragging a highlight across the text. Responder 24 then stores the location of the selected text and generates one or more CRC for the selected text.]

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine Cleron, browser-based email system, with Freivald, highlighting text document.

The modifications would have been obvious because one of ordinary skill in the art would have been motivated to combine because it allows the user to send electronic mails that contain audio, video, and text, to aid the user in identify relevant portions of the electronic mail document.

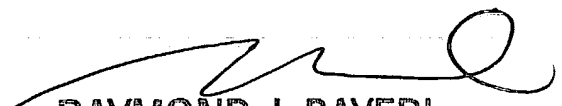
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to O'Neal R Mistry whose telephone number is (703) 305-2738. The examiner can normally be reached on 9am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W Cabeca can be reached on (703)308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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